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Paper No. 4

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MAR 16 2001

In re Application of  
David C. Cushing, M. Mitch Bulajic,  
Rohit D'Souza and Kenneth Kramer  
Application No. 09/699,503  
Filed: October 31, 2000  
Title: SYSTEM AND METHOD FOR  
EXECUTING STRATEGY SECURITY TRADING:

OFFICE OF PETITIONS  
AC PATENTS  
DECISION REFUSING STATUS  
UNDER 37 C.F.R. §1.47(a)

This is in response to the petition, filed January 25, 2001,  
under 37 C.F.R. §1.47(a).

The petition under 37 C.F.R. §1.47(a) is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

**Failure to respond will result in abandonment of the application.**

The above-identified application was filed on October 31, 2000, with three separate declarations executed by joint inventors David C. Cushing, M. Mitch Bulajic, and Kenneth Kramer on behalf of non-signing joint inventor Rohit D'Souza. Applicant has provided a copy of the return postcard receipt noting that a petition for status under §1.47(a). Having reviewed the receipt and a true copy of the petition, it is concluded that applicant has provided *prima facie* evidence that the §1.47(a) petition and petition fee should be considered filed on the filing date of the application.

On January 17, 2001, the Office mailed applicant a "Notice to File Missing Parts of Nonprovisional Application", requiring the signature of inventor D'Souza on a declaration and a surcharge under 1.16(e) for late filing of the declaration. A partially signed declaration with a petition (and fee) under 1.47 serves to avoid abandonment of the application for failure to reply to the Notice, and if the petition is grantable, satisfies the requirement for an executed declaration. Moreover, as both the declaration and the petition under 1.47 were filed on the filing date of the application, no surcharge for late filing under 1.16(e) is due. The only issue remaining is whether the petition is grantable.

Applicant asserts that §1.47(a) status is proper because joint inventor D'Souza refuses to join in the application for patent. A grantable petition under 37 C.F.R. §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the

application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirements (1) and (2).

As to item (1), Rule 47 applicant has failed to show that the non-signing inventor refused to sign the declaration after having been presented with the application papers. To meet this requirement, applicant states that "to the best of the undersigned's knowledge upon information and belief, Mr. D'Souza is a former employee of the assignee of the present patent application, was given a copy of the application to review, but has refused to sign the inventors' declaration." This statement is not supported by documentary evidence of the application papers having been presented to inventor D'Souza. Nor are details of the circumstances of the alleged refusal set forth.

Before a refusal can be alleged, applicant must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). Thus, on renewed petition, applicant must establish that the entire application package, including specification, claims and drawings, was presented to the non-signing inventor and he refused to sign. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the inventor is represented by counsel, to the address of the non-signing inventor's attorney. Documentary evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record.

Moreover, where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. When it is concluded by the rule 1.47 applicant that a non-signing inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. On request for reconsideration, applicant must be specific and fully describe the facts relied on to conclude that inventor D'Souza refuses to join in the application. Any affidavit or declaration of facts submitted must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein.

As to item (2), the declarations are not acceptable because they do not comply with 1.63(a)(3) and (c). Applicant properly left the signature block of the non-signing inventor blank under MPEP §409.03(a). However, it was not proper to leave blank the citizenship and mailing address of non-signing inventor D'Souza. To have an acceptable declaration in compliance with 1.63, the citizenship and mailing address of all inventors, regardless of signing status, must be submitted on the declaration or an application data sheet. Applicant must submit a supplemental oath or declaration or application data sheet. See 37 C.F.R. §1.67(a)(3), (4) and §1.76.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23  
2201 S. Clark Place  
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Telephone inquiries related to this decision may be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.

*EMLJ* for  
Beverly M. Flanagan  
Supervisory Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy